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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,415	07/20/2001	Judith P. Meyers	Mask	9645
5179	7590	10/30/2006	EXAMINER	
PEACOCK MYERS, P.C. 201 THIRD STREET, N.W. SUITE 1340 ALBUQUERQUE, NM 87102			SUTTON, ANDREW W	
			ART UNIT	PAPER NUMBER
			3765	

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/910,415	<b>Applicant(s)</b> MEYERS, JUDITH P.	
	<b>Examiner</b> Andrew W. Sutton	<b>Art Unit</b> 3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on 04 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/4/06 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Applicant's arguments filed 2/28/05 have been fully considered but they are not persuasive. The applicant amends claim 1 to include a curved end on first and second attachment portions being formed into an interior of said mask. The examiner feels that this amendment fails to overcome the prior art as Olson teaches in Fig. 3 a curved portion 11 being on the interior of said mask. Honsaker teaches a curved portion 14 on the interior of said mask in Fig 1.

### ***Claim Rejections - 35 USC § 112***

2. Claims 1-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant amended the claims to include the mask having a substantially opaque face portion of the mask. The applicant fails to disclose the fold being in the originally filed specification or drawing.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6, 8-14, 17, 19, 21, 23-31, 33-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Honsaker (US 3,237,204). Honsaker illustrates in Fig. 1 a mask formed in a decorative pattern formed of a single piece of a pliable material 11 (Col. 1 lines 18-19). The mask includes a first and second attachment portions 17, which are integrated into the pattern of the mask, for joining to eyeglasses (Fig. 2).

As to claims 8, 19, 33, and 38, Even though product-by-process claims are limited by a process, the determination of patentability is based on the product itself. If the product by process claims is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). In the instant application the mask product as defined in claim 19 is same as the mask product in 10, Figs. 1 and 2 disclosed by Honsaker.

As to claims 2-3, Honsaker teaches (Col. 1 line 18) that the mask can be made of paper and cardboard.

As to claim 6, Honsaker teaches that the visor is made from cutting (Col. 2 line 5).

As to claim 9, as best understood, Honsaker illustrate in Fig. 2

As to claim 10, Honsaker illustrates in Fig. 2 that the mask 10 is bendable which would allow for glasses of various sizes fit in the mask. Secondly, makes it inherent that it would allow various size eyeglasses.

As to claim 11, Honsaker illustrates in Fig. 1 the mask 10 being formed of a single sheet 11.

As to claims 12, Honsaker illustrates in Fig. 1 a mask formed in a decorative pattern formed of a single piece of a pliable material 11 (Col. 1 lines 18-19). The mask includes a first and second attachment portions 17, which are integrated into the pattern of the mask, for joining to eyeglasses (Fig. 2).

As to claims 13-14, Honsaker teaches (Col. 1 line 18) that the mask can be made of paper and cardboard.

As to claim 17, Honsaker teaches that the visor is made from cutting (Col. 2 line 5).

As to claim 21, Honsaker illustrates in Fig. 2 that the mask 10 is bendable which makes it inherent that it would allow various size eyeglasses.

As to claims 23, as best understood, Honsaker illustrates in Fig. 1 a mask formed in a decorative pattern formed of a single piece of a pliable material 11 (Col. 1 lines 18-19). The mask includes a first and second attachment portions 17, which are integrated into the pattern of the mask, for joining to eyeglasses (Fig. 2). Honsaker illustrates in Fig 2. that the attachment means 17 are folded inward.

As to claim 24, Honsaker illustrates in Fig. 1 the mask 10 being formed of a single sheet 11.

As to claim 25, Honsaker illustrates in Fig. 1 the mask 10 is made of a substantially flat material.

As to claims 26, as best understood, Honsaker illustrates Fig. 2 the attachment members of the make are folded and attached to the eyeglasses.

As to claim 27, Honsaker illustrates Fig. 1 that the mask is made of a substantially flat material.

As to claim 28, Honsaker illustrates in Fig. 1 that the mask is a substantially flat material and then in Fig. 2 Honsaker illustrates that the attachment members 17 are folded inward which allow them to be attached to the glasses.

As to claims 29, Honsaker teaches (Col. 1 line 18) that the mask can be made of paper and cardboard.

As to claim 30, Honsaker illustrates in Fig. 2 that the mask 10 is bendable which makes it inherent that it would allow various size eyeglasses.

As to claim 31, Honsaker teaches that the visor is made from cutting (Col. 2 line 5).

As to claims 34, as best understood, Honsaker illustrates in Fig. 1 a mask formed in a decorative pattern formed of a single piece of a pliable material 11 (Col. 1 lines 18-19). The mask includes a first and second attachment portions 17, which are integrated into the pattern of the mask, for joining to eyeglasses (Fig. 2). Honsaker illustrates in Fig 2. that the attachment means 17 are folded inward.

As to claim 35, Honsaker illustrates in Fig. 2 that the mask 10 is bendable which makes it inherent that it would allow various size eyeglasses.

As to claim 36, Honsaker teaches that the visor is made from cutting (Col. 2 line 5).

Claim are 1, 4, 8, 9-11, 12, 15, 18-21, 22-25, 30, 33-35, 37-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Olson (US 5,206,956). Olson illustrates in Fig.

1 and 2 a mask formed in a decorative manner of a single piece of pliable material (Col. 2 line 24). The mask includes first and second attachment means 15 that are integrated in the pattern of the mask, which attach the mask to the eyeglasses.

As to claim 10, 21, 30, 35 Olson illustrates in Fig. 2 that the mask 10 is bendable which would allow for glasses of various sizes fit in the mask. Secondly, Olson states in Col. 2 line 52 that the device fits typically sized glasses. This makes it inherent that the device of Olson would allow various size eyeglasses.

As to claims 8, 19, 33, and 38, Even though product-by-process claims are limited by a process, the determination of patentability is based on the product itself. If the product by process claims is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). In the instant application the mask product as defined in claim 19 is same as the mask product in 10, Figs. 1, 3 disclosed by Olson.

As to claim 4, Olson states (Col. 2 line 34) that the mask is made of plastic.

As to claim 7, Olson states (Col. 2 line 46) that die-cutting is used to form the mask.

As to claim 9, as best understood, Olson illustrates in Fig. 2 the attachment member 15 is folded inward at 14 to allow for the reception of the eyeglasses.

As to claim 11, Olson illustrates in Fig. 2 the device is made of a single sheet.

As to claim 12, Olson illustrates in Fig. 1 and 2 a mask formed in a decorative manner of a single piece of pliable material (Col. 2 line 24). The mask includes first and

second attachment means 15 that are integrated in the pattern of the mask, which attach the mask to the eyeglasses.

As to claim 15, Olson states (Col. 2 line 34) that the mask is made of plastic.

As to claim 18, Olson states (Col. 2 line 46) that die-cutting is used to form the mask.

As to claim 20, as best understood, Olson illustrates in Fig. 2 the attachment member 15 is folded inward at 14 to allow for the reception of the eyeglasses.

As to claim 22, Olson illustrates in Fig. 2 the device is made of a single sheet.

As to claim 23, as best understood, Olson illustrates in Fig. 1 and 2 a mask formed in a decorative manner of a single piece of pliable material (Col. 2 line 24). The mask includes first and second attachment means 15 that are integrated in the pattern of the mask, which attach the mask to the eyeglasses. The attachment means are shown in Fig. 3 to be folded to allow for the reception of the glasses.

As to claim 24, Olson illustrates in Fig. 2 the device is made of a single sheet.

As to claim 25, Olson illustrates in Fig. 2 the mask 10 is substantially flat.

As to claim 34, as best understood, Olson illustrates in Fig. 1 and 2 a mask formed in a decorative manner of a single piece of pliable material (Col. 2 line 24). The mask includes first and second attachment means 15 that are integrated in the pattern of the mask, which attach the mask to the eyeglasses. The attachment means are shown in Fig. 3 to be folded to allow for the reception of the glasses. The mask 10 is folded inward at 14 as shown in Fig. 3.



As to claim 37, Olson states (Col. 2 line 46) that die-cutting is used to form the mask.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 16, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honsaker (US 3,237,204) in view of Piper (US 3,823,418). Honsaker illustrates the device substantially above. However, Honsaker does not teach the mask being made of fabric. The applicant does not teach any unexpected results or criticality to the use of fabric. It would have been obvious to one of ordinary skill in the art to combine the structure of Honsaker with the fabric of Piper to provide a more aesthetically pleasing mask.

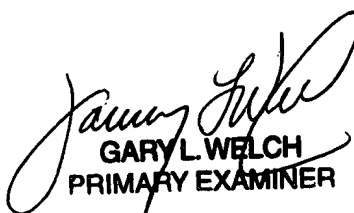
### ***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew W. Sutton whose telephone number is (571) 272-6093. The examiner can normally be reached on Monday - Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary L. Welch can be reached on (571) 272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AWS  
25 October 2006

  
GARY L. WELCH  
PRIMARY EXAMINER